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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,233	11/25/2003	Jun Nagai	00862.023390.	4340
5514 7590 09/06/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/720,233

Applicant(s)

NAGAI, JUN

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention in claims 9 and 10 are directed to non-statutory subject matter. Claims 9 and 10 are rejected under 35 U.S.C. 101 because they are directed towards an abstract idea. Under the current 101 guidelines (specifically, page 30 "Annex I"), there are three 101 judicial exceptions – law of nature, natural phenomenon, and abstract idea. A program is simply a set of instructions and does not produce a physical transformation or a tangible result. The suggested correction is to amend the claims to "A computer-readable medium encoding a program containing instructions for processing printing based upon data..." and canceling claim 11, which would already be included in the amended claim 9.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2625

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Sobue (U.S. Patent No. 5,610,728)

Regarding claims 1, 5, 9, 11, Sobue discloses an image processing apparatus which processes printing based upon data, comprising:

print mode acquisition means which acquires a type of a print mode set by a user out of a plurality of print modes including a first mode for printing an image based upon data (Fig. 4, N6 – B4 printing), a second mode for printing another image instead of the image based upon data (Fig. 4, item N2, N3, N4 – produce a reduced image), and

It does not explicitly disclose “a third mode for not printing the image based upon data;”

However, based upon the way the limitation is stated in the claim, it can be interpreted simply as not printing the image at all. This “mode” is an inherent aspect of any printing apparatus, which is simply to not choose a print option.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a mode to not print an image.

The motivation would have been to prevent from printing an image that is not desired (e.g. print previews show distorted or incorrect image)

Therefore, it would have been obvious to improve Sobue to obtain the invention as specified.

Sobue further discloses control means which controls print processing according to the type of the print mode acquired by said print mode acquisition means. (Fig. 4, N4 – reducing information or Fig. 5 shows magnifying/reduction of an image to properly fit on a page. The other processing path is B4 printing.)

Regarding claims 2, 6, Sobue discloses the image processing apparatus according to claim 1, wherein, in said second mode, information indicating reference to image data to be acquired is printed instead of an image based upon the image data to be acquired. (the second mode produces only an representation of the actual image in the reduced form in Fig. 4)

Regarding claims 3, 7, 10, Sobue discloses the image processing apparatus according to claim 1, further comprising reception means which receives data constituted of a plurality of image data, (column 5, lines 37-41)

wherein said control means controls the print processing so as to print images based upon the respective plurality of image data in the case where said first mode is set (Fig. 4, N6 – B4 printing), controls the print processing so as to print other images instead of the images based upon the respective plurality of image data in the case where said second mode is set (Fig. 4, item N2, N3, N4 – produce a reduced image), and controls the print processing so as not to print the images based upon the respective plurality of image data in the case where said third mode is set. (again, the option to not print is inherent)

Regarding claims 4, 8, Sobue discloses the image processing apparatus according to Claim 1, further comprising reception means which receives data constituted of image data, position information corresponding to the image data (position data is inherent portion of the print job – see for example Fig. 5 where the images are positioned in various locations) , and identification information identifying the image data, (Fig. 4, item N3 – reduction flag identifies that a reduced image needs to be printed)

wherein the position information indicate a position where the image data should be printed, (the position information is an inherent part of a print job since properly printing a print job includes identifying the proper position on a page to print the job)

said control means controls the print processing so as to print an image based upon the image data in a position indicated by the position information in the case where said first mode is set (Fig. 4, item N6), controls the print processing so as to print an image based upon the identification information in the position indicated by the position information instead of the image based upon the image data in the case where said second mode is set (Fig. 4, items N2, N3, N4 and Fig. 5, item C) , and controls the print processing so as not to print the image based upon the image data in the position indicated by the position information in the case where said third mode is set. (again, this can be interpreted simply as not printing the image, and the option to not print is inherent)

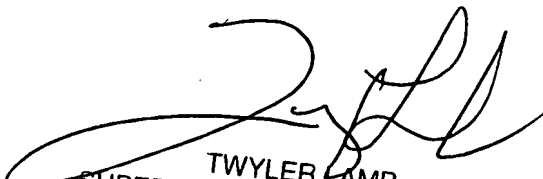
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
YQ

  
TWYLER LAMB  
SUPERVISORY PATENT EXAMINER